

REMARKS

Reexamination and reconsideration is respectfully requested in light of the foregoing amendments to the claims and following remarks.

Claims 1-8, 10, 11, 13, 15-19 and 22-27 are pending in this application. Claims 20 and 21 have been canceled without prejudice or disclaimer. Claims 9, 12, and 14 were canceled by previous amendments. Claims 1, 7, 8, 10, 13 and 22 have been amended. New claims 23-27 have been added. No new matter has been added to the application. Support for the amendments can be found at paragraphs [0106] to [0110] of the specification. Support for the new claims can be found at paragraphs [0100], [0106] to [0110], [0117] and [0120] of the specification.

Applicant notes the Examiner's acceptance of the drawings filed February 6, 2002. Applicant further notes the Examiner's acknowledgment of Applicant's claim for foreign priority under 35 U.S.C. § 119 and receipt of the certified priority document.

Rejection Under 35 U.S.C. 112

Claims 1-6 and 22 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. In particular, the Examiner finds that independent claims 1 and 22 do not specify whether the reader and generator are program or operating components.

The test of enablement is whether one skilled in the art could make or use the claimed invention from the disclosures in the specification coupled with information known in the art without undue experimentation. *United States V. Telecommunications, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), *cert. denied*, 490 U.S. 1046 (1989); *In re Stephens*, 529 F.2d 1343, 1345, 188 USPQ 659, 661 (CCPA 1976). Determining enablement is a question of

law based on underlying factual findings. *In re Vaeck*, 947 F.2d 488, 495, 20 USPQ2d 1438, 1444 (Fed. Cir. 1991); *Atlas Powder Co. v. E.I. Du Pont De Nemours & Co.*, 750 F.2d 1569, 1573, 224 USPQ 409, 411 (Fed. Cir. 1984). In determining whether a disclosure would require undue experimentation to make the claimed subject matter, the Examiner must consider the quantity of experimentation necessary, the amount of direction or guidance presented, the presence or absence of working examples, the nature of the invention, the state of the prior art, the relative skill of those in the art, the predictability or unpredictability of the art, and the breadth of the claims. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404, (Fed. Cir. 1988), citing with approval *Ex parte Forman*, 230 USPQ 526, 547 (Bd. Pat. App. & Int. 1986). The burden is on the Examiner to establish a reasonable basis to question the adequacy of Applicant's disclosure. *In re Marzocchi*, 439 F.2d 220, 223-224, 169 USPQ 367, 370 (CCPA 1971).

The Examiner made a finding that the "Specification states that the reader and generator are components of a program such as an operating system and various applications that are executable by a computer (pages 10-12, ¶¶0050-0055)." The specification gives sufficient guidance to one skilled in the art as to the source of these components by virtue of the paragraphs pointed out by the Examiner. The Examiner has not explained what quantity of experimentation would be necessary to determine whether the reader and generator are components of a program or the operating system. The Examiner has not established the state of the art that distinguishes between application and operating systems that would require undue experimentation by a person having ordinary skill in the art. Further, the Examiner has not presented any cogent reasons why the unpredictability of the art would lead to undue experimentation.

For these reasons, it is respectfully requested that the rejection of the claims under the first paragraph of 35 U.S.C. § 112 be reconsidered and withdrawn.

Rejection Under 35 U.S.C. 102

Claims 1-8, 10, 11, 13 and 15-19 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Feld (U.S. Published Application No. 2001/0026272). The Examiner did not find our previous arguments persuasive because the reference discloses a reader, observation image generator and a display device.

Independent claims 1, 7, 8, 10, 13 and 22 have been amended to clarify the invention. The claims as amended require a positional relationship between the image of the commercial article and the image of the article for comparison on a single screen. The position of the image of the article for comparison can be moved relative to the image of the commercial article. See Fig. 11. This feature is not disclosed by Feld, which discloses fitting a commercial product (clothing) onto a presized human body. Feld does not disclose or suggest that the clothing can be moved relative to the human body. Similarly, the human body is not moved relative to the clothing. Therefore Feld does not disclose the positional relationship feature of the claimed invention.

Moreover, the independent claims require that the invention provide a visual recognition of the size of the commercial product compared to the size of the article for comparison. Feld does not teach this feature of the invention. The commercial product in Feld is the clothing. The article for comparison is the human body. Once the human body is adjusted, the size of the clothing is automatically adjusted. Therefore, Feld is not capable of comparing of an original size of the commercial product to a human body after it has been sized. The purpose of Feld is not to compare a fixed size of clothing to a sized human body, but to size the clothing to fit a

sized human body. Further, the relative dimensions of the commercial product of the present invention are predetermined, that is the dimensions do not change. For example, if the commercial product is a 6 x 9 rug, it is always a 6 x 9 rug. The rug is not automatically sized to fit the image of the article for comparison.

For these reasons, Feld does not present a *prima facie* case of anticipation. It is respectfully requested that the rejection under 35 U.S.C. 102(e) as anticipated by Feld be reconsidered and withdrawn.

New Claims

New claims 23-27 have been added. New claim 23 further limits claim 1 and allows for changing the size of the image of the article for comparison relative to the commercial article. Claim 24 is dependent on claim 23 and further limits claim 23 to a zooming in or zooming out feature. Both claims are believed patentable since they are dependent on claim 1.

New independent claim 25 has been added with two dependent claims, claims 26 and 27. Claim 25 is directed to an electronic catalog system similar to claim 1, wherein the system provides for a predetermined size for the article for comparison. Claim 25 contains the positional relationship feature as well as the size comparison feature as set forth in claim 1. For the same reasons as set forth in the arguments for claim 1, it is believed that new claims 25-27 are patentable.

Conclusion

For the foregoing reasons, it is submitted that the claims 1-8, 10, 11, 13, 15-19 and 22-27 are patentable over the teachings of the prior art relied upon by the Examiner. Accordingly,

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favorable reconsideration of the claims is requested in light of the preceding amendments to the claims and remarks. Allowance of the claims is courteously solicited.

If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. § 1.17 and due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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